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HOWREY LLP			WONG, STEVEN B	
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Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No.	Applicant(s)	
	10/568,050	LIM, ENG TAT	
	Examiner	Art Unit	
	Steven Wong	3711	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) Responsive to communication(s) filed on 22 January 2008.
- 2a) This action is **FINAL**. 2b) This action is non-final.
- 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) Claim(s) 1-10 and 12-21 is/are pending in the application.
 - 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) Claim(s) _____ is/are allowed.
- 6) Claim(s) 1-10 and 12-21 is/are rejected.
- 7) Claim(s) _____ is/are objected to.
- 8) Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) The specification is objected to by the Examiner.
- 10) The drawing(s) filed on 22 January 2008 is/are: a) accepted or b) objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
 - a) All b) Some * c) None of:
 1. Certified copies of the priority documents have been received.
 2. Certified copies of the priority documents have been received in Application No. _____.
 3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ . |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____ . | 6) <input type="checkbox"/> Other: _____ . |

Drawings

1. The drawings are objected to under 37 CFR 1.83(a). The drawings must show every feature of the invention specified in the claims. Therefore, the second position as defined in Claim 12 wherein the support portion (16) and the prong members (40) are disposed substantially within the cavity (15) must be shown or the feature(s) canceled from the claim(s). No new matter should be entered.

Corrected drawing sheets in compliance with 37 CFR 1.121(d) are required in reply to the Office action to avoid abandonment of the application. Any amended replacement drawing sheet should include all of the figures appearing on the immediate prior version of the sheet, even if only one figure is being amended. The figure or figure number of an amended drawing should not be labeled as "amended." If a drawing figure is to be canceled, the appropriate figure must be removed from the replacement sheet, and where necessary, the remaining figures must be renumbered and appropriate changes made to the brief description of the several views of the drawings for consistency. Additional replacement sheets may be necessary to show the renumbering of the remaining figures. Each drawing sheet submitted after the filing date of an application must be labeled in the top margin as either "Replacement Sheet" or "New Sheet" pursuant to 37 CFR 1.121(d). If the changes are not accepted by the examiner, the applicant will be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

Specification

2. The disclosure is objected to because of the following informalities: the specification fails to describe that which is depicted in new Figure 8. The amendment provides new Figure 8,

however, the specification has not been amended to refer to Figure 8, for example, in the “Description of An Embodiment of the Invention”.

Appropriate correction is required.

Claim Rejections - 35 USC § 112

3. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

4. Claims 1-10 and 12-21 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. Claims 1 and 12 have been amended to define the plurality of upright prong members as being rigid. The originally filed specification fails to state that the prong members are formed from a rigid material. The applicant points to page 9, line 23 through page 10, line 3 as providing sufficient support. However, this passage merely states that a club blow to the prong members causes the members to move to a horizontal position. The passage does not state that the prong members are formed from a rigid material. The ability for the prong members to move to the horizontal position is not seen as being exclusive to a rigid material as a flexible material would inherently be capable of movement to the horizontal position when struck by a golf club head.

5. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

6. Claims 8-10 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. In claim 8, the horizontal surface for the stopper portion is unclear. The claim defines a substantially horizontal upper surface that is provides with downwardly sloping surface. It is unclear how the surface may be horizontal and yet include a downwardly sloping surface.

Claim Rejections - 35 USC § 103

7. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

8. Claims 1-5, 7-10 and 16-18 are rejected under 35 U.S.C. 103(a) as being unpatentable over Morabeto (4,645,208) in view of Nial et al. (1,551,207) and Blair (4,004,814). Regarding claim 1, Morabeto discloses a golf tee construction comprising a shaft (1) adapted for insertion into a ground surface and a pivotable support portion (6) mounted atop an upper end of the shaft. The pivotable support portion is pivotable relative to the longitudinal axis of the shaft (note Figure 5). However, Morabeto lacks the teaching for the support portion to comprise a plurality of rigid upright prong members of equal length.

Nial reveals a golf tee comprising a support portion (1) having a plurality of upright prong members (3) of equal length extending therefrom. It would have been obvious to one of ordinary skill in the art to provide the golf tee of Morabeto with the plurality of prong members as taught by Nial in order to minimize the frictional contact between the ball and the tee.

However, the combination of Morabeto in view of Nial lacks the teaching for the prong members to be formed from a rigid material.

Blair discloses a golf tee construction comprising a shaft member (20) that is inserted into the ground and a ball support element (10). Note column 1, lines 41-45 and column 2, lines 26-29 of Blair. Blair suggests forming the ball support element from a material that is sufficiently rigid in order to properly support a golf ball and that is sufficiently flexible in order to absorb the shocks of being struck by a golf club head. It would have been obvious to one of ordinary skill in the art to form the prong members of Nial from a material that is sufficiently rigid in order to support a golf ball and that is sufficiently flexible in order to absorb the shocks of being struck by a golf club head in order to make a durable product that will function properly by fully supporting the golf ball thereon.

Regarding claims 2-5, Morabeto provides an upper portion (5) and a lower portion (3) for the pivotable support portion. Morabeto teaches for the pivotable connection means to comprise a ball and socket assembly wherein the lower portion comprises a socket and the upper portion comprises a ball.

Regarding claim 7, Morabeto provides a stopper portion (2) on his shaft.

Regarding claims 8 and 9, insofar as claim 8 may be understood, Morabeto teaches the claimed structure. Morabeto provides a downwardly sloping surface (3) and a horizontal upper surface (2). It would have been obvious to one of ordinary skill in the art to provide a downwardly sloping surface with a gradient of 25 degrees as the applicant has not stated the particular criticality for this angle and it appears that the angle of Morabeto would accomplish similar purposes.

Regarding claim 10, note Figures 1 and 2 of Morabeto showing markers (4) that are disposed diametrically opposite the sloping surface 93). The markers are obviously capable of being used as guidance markers.

Regarding claim 16, the prong members of Nial are equidistantly and equiangularly arranged. Further, the prong members would obviously provide minimal contact with the golf ball.

Regarding claim 17, the length of the prong members of Nial are the same.

Regarding claim 18, the prong members of Nial are obviously capable of being varied to suit a particular intended golf stroke.

9. Claim 6 is rejected under 35 U.S.C. 103(a) as being unpatentable over Morabeto (4,645,208) in view of Nial et al. (1,551,207), Blair (4,004,814) and Liu (US 2004/0018896). Liu discloses that it is well known in the art of golf tees to form the shaft of the tee from two portions (20, 30) so that the tee may be separated to provide a short golf tee and a longer golf tee. It would have been obvious to one of ordinary skill in the art to provide a threaded connection for the shaft of the golf tee of Morabeto in order to permit the user to remove the pivotable section and use the tee as a short golf tee.

10. Claims 12-15, 19 and 20 are rejected under 35 U.S.C. 103(a) as being unpatentable over Harvey (2,457,670) in view of Chase (3,414,268) and Blair (4,004,814). Regarding claim 12, Harvey discloses a golf ball tee comprising a base portion (10) having a cavity (11) and a pivotable support portion (25). The pivotable support portion (25) is pivotable relative to the base (10) between a first position (Figure 6) and a second position (Figure 5) in which the support portion (25) is substantially within the cavity of the base portion. It would have been

obvious to one of ordinary skill in the art to form the ball support portion of Harvey with a plurality of prong members as taught by Chase in order to limit the effect of the ball support portion on the flight of the golf ball. Further, it would have been obvious to one of ordinary skill in the art to form the ball support portion from a material that is sufficiently rigid in order to support a golf ball and that is sufficiently flexible in order to absorb the shocks of being struck by a golf club head in order to make a durable product that will function properly by fully supporting the golf ball thereon.

Regarding claims 13-15, note Figure 2 of Chase. The prongs appear to comprise pointed ends and define generally conical shapes. It would have been obvious to one of ordinary skill in the art to form the golf tee of Harvey with three prongs as the applicant has not disclosed the criticality for this particular number and it appears that the number of prongs taught by Chase would accomplish similar purposes. Further, it would have been obvious to one of ordinary skill in the art to form the golf tee of Harvey with prongs in the shape taught by Chase in order to limit the effect of the ball support on the flight of the golf ball.

Regarding 19 and 20, Harvey appears to provide a rectangular aperture (11) that has a substantially flat horizontal surface. In the alternative, it would have been obvious to form the surface (11) as a flat surface in order to provide a proper support for the pivotable support portion (25) when in the secondary position. Further, Harvey includes a downwardly sloping surface extending around the surface of the base portion (10). The surface would obviously face a striking surface of a golf club. It would have been obvious to one of ordinary skill in the art to form the surface with a slope of 25 degrees as the applicant has not shown the criticality for this

particular degree and it appears that the slope taught by Harvey would accomplish similar purposes.

11. Claim 21 is rejected under 35 U.S.C. 103(a) as being unpatentable over Harvey (2,457,670) in view of Chase (3,414,268), Blair (4,004,814) and Willey (1,866,143). Willey discloses that it is well known in the art of golf tees to provide either one tee alone (Figure 1) or as a plurality of tees on a teeing surface (Figure 5). It would have been obvious to one of ordinary skill in the art to provide three of the tees of Harvey next to one another in order to permit multiple users to play at the same time.

Response to Arguments

12. Applicant's arguments filed January 22, 2008 have been fully considered but they are moot in view of the new grounds of rejection. Applicant's arguments directed to the rejection under 35 U.S.C. 102(b) have been considered but are deemed to be moot. The applicant has amended claim 1 to further define the prong members as being rigid. First, as stated above, this language constitutes new matter as the originally filed specification fails to set forth this limitation. Second, the amendment necessitated the new grounds of rejection over the combination of Morabeto in view of Nial and Blair. The reference to Morabeto states that the golf ball supporting portion may be formed from a rigid material. However, the reference to Nial states that the prong members are preferably made from a flexible material. The reference to Blair teaches that it is well known in the art of golf tees to form the ball supporting member from a material that is flexible enough to withstand impacts with a golf club head and that is rigid enough to properly support a golf ball. It would have been obvious to one of ordinary skill in the art to form the golf tee supporting portion of Morabeto as modified by Nial from a rigid yet

flexible material in order to properly support the golf ball and also permit the golf tee to withstand repeated impacts with a golf club head.

Regarding the applicant's argument that the petals of Chase are not upright, these arguments are moot in view of the new grounds of rejection. The reference to Nial teaches upright prong members.

Regarding the rejection under 35 U.S.C. 103(a), the applicant argues that the combination of Chase and Morabeto does not teach the recited upright rigid prong members. However, this argument is moot over the new grounds of rejection. The combination of Morabeto in view of Nial and Blair teach the recited upright rigid prong members as set forth above.

Regarding claims 8 and 9, the applicant argues that Morabeto does not provide a substantially horizontal upper surface. This argument is not persuasive as the stop portion (2) provides a horizontal upper surface. Note Figures 1-3 showing the stopper portion including a horizontal upper surface (noted generally at 2). Further, the stopper portion includes a downwardly sloping surface (3).

Regarding claim 10, the applicant argues that element (4) of Morabeto is merely a "U"-shaped opening and cannot operate as a guidance marker because they extend over nearly 120 degrees as shown in Figures 1-3 of Morabeto. The applicant also argues that Morabeto teaches away from a guidance marker because he provides a universal joint between the ball support portion and the ground insertion portion. However, these arguments are not persuasive as the opening of Morabeto is obviously capable of functioning as a guidance marker. The opening clearly would provide to the user a marker that one of ordinary skill in the art could use for guidance purposes. Further, the fact that the markers extend over nearly 120 degrees does not

change their ability to be used as a means for guiding a player. The applicant appears to be arguing a difference in structure that is not presented in the claims. Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993). Further, the passage cited by applicant is not seen as teaching away from the openings being used as guidance markers. Simply because Morabeto teaches a universal joint does not prevent the opening from being used by one of ordinary skill in the art for guidance or alignment purposes. Further, it is noted that the language “guidance” relates to the intended use of the marker. A recitation of the intended use of the claimed invention must result in a structural difference between the claimed invention and the prior art in order to patentably distinguish the claimed invention from the prior art. If the prior art structure is capable of performing the intended use, then it meets the claim. Here, the applicant has failed to provide any structural limitations associated with the guidance marker other than it is located diametrically opposite the downwardly sloping surface. Morabeto teaches this arrangement by providing the openings diametrically opposite the downwardly sloping surfaces (3).

Regarding claim 6, the applicant argues that Liu does not provide the upright prong members. However, this argument is not persuasive as the reference to Liu is relied upon merely for its teaching that it is well known in the art of golf tees to form the tee from two portions so that the tee may be separated. The combination of Morabeto in view of Nial provides a golf tee with upright prong members.

The applicant’s arguments directed to claim 11 have been considered but are moot as the applicant has canceled that claim.

Regarding claim 16, the applicant argues that the combination of Chase in view of St. John does not teach upright prong members that will have minimal contact with a golf ball. This argument has been considered but is deemed to be moot in view of the new grounds of rejection.

Regarding claims 12-15 and 19-21, the applicant argues that the combination of Jewett in view of Cardarelli does not teach the claimed invention as amended. However, the applicant's arguments have been deemed to be moot in view of the new grounds of rejection. The applicant's amendments to claim 12 to further clarify the pivotal movement and the recitation for the prong members to be rigid necessitated the new grounds of rejection.

Conclusion

13. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Steven Wong whose telephone number is 571-272-4416. The examiner can normally be reached on Monday through Friday 7am-3:30pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Gene Kim can be reached on 571-272-4463. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Steven Wong/
Primary Examiner, Art Unit 3711